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07/28/92

☒ This application has been examined ☒ Responsive to communication filed on 5/6/92 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☒ Notice of Art Cited by Applicant, PTO-1449 (9 sheets)
4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 10-19, 22, 24-26, 36-42, 45-48, 51-53, 74, 75, 102, 103, and 127-130 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☒ Claims 1-9, 20, 21, 23, 27-35, 43, 44, 49, 50, 54-73, 76-101, and 104-126 have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 10-19, 22, 24-26, 36-42, 45-48, 51-53, 74, 75, 102, 103, and 127-130 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____ ; filed on _____.

13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

If applicant desires priority under 35 U.S.C. § 120 based upon a parent application, specific reference to the parent application must be made in the instant application. It is noted that this appears as the first sentence of the specification following the title. Status of the parent application (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "Patent No." should follow the filing date of the parent application. If a parent application has become abandoned, the expression "abandoned" should follow the filing date of the parent application.

Applicants' arguments filed 5/6/92 have been fully considered and but they are not deemed to be persuasive to overcome all of the previously applied rejections. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are newly applied or reiterated from the previous office action. They constitute the complete set presently being applied to the instant application.

35 U.S.C. § 101 reads as follows:

> "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

Claims 10-19, 22, 24-26, 36-42, 45-48, 51-53, 74, 75, 102, 103, and 127-130 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 10-19, 22, 24-26, 36-42, 45-48, 51-53, 74, 75, 102, 103, and 127-130 of copending application Serial No. 07/497,098. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. It is noted that claims 42 and 45 are alittle different between the above two

applications but the Examiner deems these differences to not alter the scope of the claims in total so as to prevent their inclusion in the above rejection. This is a new rejection necessitated by the amendment filed 5/6/92.

Claims 10-12, 22, and 36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 51, 112, and 114 of copending application Serial No. 07/627,707. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both directed to hybridization practice diagnostic of CML. The difference in scope of the claims are obvious different chromosomal target notations that appear to be obvious as the same target practice although the instant application is more specific as to chromosomal locations than 07/627,707.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. This rejection is necessitated by the amendment filed 5/6/92.

No claim is allowed.

Applicants' amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a

final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Papers related to this application may be submitted to Group 180 by facsimile transmission. Papers should be faxed to Group 180 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

The CM1 Fax Center number is (703) 308-4227.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

A. MARSCHEL:am

July 27, 1992

MARGARET MOSKOWITZ
SUPERVISORY PATENT EXAMINER
GROUP 180